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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,449	01/23/2004	Bruce W. Anderson	GPI06-11.DV4	9247
21365 7590 04/21/2008 GEN PROBE INCORPORATED 10210 GENETIC CENTER DRIVE Mail Stop #1 / Patent Dept. SAN DIEGO, CA 92121				
EXAMINER RAMDHANE, BOBBY				
ART UNIT 1797		PAPER NUMBER		
NOTIFICATION DATE 04/21/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdept@gen-probe.com

kellecc@gen-probe.com

belindao@gen-probe.com

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/763,449

**Applicant(s)**

ANDERSON ET AL.

**Examiner**

BOBBY RAMDHANIE

**Art Unit**

1797

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 07 April 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Walter D. Griffin/  
Supervisory Patent Examiner, Art Unit 1797

Continuation of 11, does NOT place the application in condition for allowance because:

Response to Arguments

Applicant's arguments filed 04/07/2008 have been fully considered but they are not persuasive. The Following reasons are why:

1. Applicants' claims are toward an automated method for removing a fluid substance from a collection device comprising a fluid-holding vessel and a cap. In applicant's remarks, applicants allege that the claimed methods require that the fluid transfer device used to draw and remove a fluid substance from a fluid-holding vessel is the same fluid transfer device used to puncture a surface of an associated cap. Although this may be the applicant's intentions, the claims of the instant application do not truly reflect this. For example, Claim 1 is an open-ended claim (see comprising not consisting), it may contain more steps (ones that are not recited) and it may claim other devices in conjunction with the method such as the mechanical structure of the automated device. It is reasonable to think that more than one fluid transfer device, may be claimed. The construction of the claims does not allow one to assume that the fluid transfer device that punctures the cap (Step a), and the one of Step b, to remove the fluid, are the same one.
2. McGregor et al discloses two fluid transfer devices - one that punctures the cap and an apparatus that removes the fluid (which applicant has described in detail in their Remarks of 04/07/2008). McGregor et al defines one fluid transfer device (See Item 12). McGregor et al also defines a second fluid transfer device (See stem and bulb Items 22 & 24). Applicant's Specification defines a fluid transfer apparatus as "a device which facilitates the movement of fluids into or out of a fluid transfer device (See Page 31 lines 27-29)." Therefore, the stem and bulb may also be considered a fluid transfer device. This reasoning is consistent in light of the Specification which allows for the fluid transfer apparatus to be manually operated (See Page 31 lines 25-27).
3. In regards to applicant's argument that dependent claims recite a pipette tip, the descriptor of "pipette" in "pipette tip" refers to the device on which a tube or hollow cylinder may be attached to a mechanical device or bulb which suction is applied or a vacuum such as a pipettor (but not limited to) to facilitate the removal of fluid from one location to another. Alternatively a "pipette tip" may define the very bottom opening for which the fluid flows through. A cannula may be attached to a bulb or pipettor and which may define a "pipette tip" and the cannula also inherently has a "tip." Applicants have also stated in their arguments that the method has dependent claims directed to the pipette tip and its construction. The references previously applied in combination with McGregor et al cure these deficiencies (For Example, see Claim 1 - no where is the claim is a pipette tip recited. If it were to be claimed, other references used in the Final Rejection would allow obviousness rejections to be applied. In addition, a number of references cited at the end of this section provide evidence of obviousness as to why a pipette tip may be used. A number of the references below solve the problem which the applicant is alleging as novel.
4. It would have been obvious to replace the bulb in McGregor et al with a pipettor because this would allow for precise and accurate volumes to be removed from the vial whereas the bulb would not give this precise measurement. Examples of where this would be appropriate are the following: Adding precise amounts of ethanol to a DNA extraction sample, addition of small amounts of Ethidium Bromide to an Agarose gel (since it is a potent mutagen, and you do not get any of it on your fingers or on yourself, and don't want to spread a mutagen such as this around the lab), and for the removal of radioactive isotopes from vials for use in ELISA assays, radiolabelling antibodies, as well as fluxes for oocytes to measure metal ion concentration gradients.
5. The argument that the method is performed by two separate components is not a valid argument because the Claims of the instant application are toward methods (For Example See Claim 1). The same method can be performed with separate components that are combined together and still obtain the same degree of success (Examiner would like to note that both components are taught in the same reference so the amount of obviousness needed to make as well as maintain this rejection is minimal, if that.
6. The rejections in the Office Action are reasonable in light of the prior art of record and are therefore maintained.

The Examiner would like to bring to Applicant's attention the following prior art references:

US: 6030582, 6361744, 5517687, 5130254, 3901219, & 2436291;

EP: 699910 A1; and

WO 9119181 A1

The above prior art references are relevant to the method claims of the instant application. These references further support the fact that the claims of the instant application are not novel. The above relevant prior art references anticipate and/or obviate the claims of the instant application.